



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,338	03/01/2002	John p. Ruckart	010417	4121

36192 7590 02/09/2005

CANTOR COLBURN LLP
55 GRIFFIN ROAD SOUTH
BLOOMFIELD, CT 06002

EXAMINER

HASHEM, LISA

ART UNIT	PAPER NUMBER
----------	--------------

2645

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/086,338	Applicant(s) RUCKART, JOHN P.	
	Examiner Lisa Hashem	Art Unit 2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Examiner acknowledges the cancellation of claims 1-5 in the Amendment filed on January 14, 2005.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 6-13 and 17-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

For example, claims 6 and 17 recite the following limitation, "receiving one or more parameters of a hold function via a web interface, wherein said parameters are selected from the group consisting of a schedule including at least one time period during which the incoming call is placed on hold, and a list including at least one potential calling party from whom incoming calls are placed on hold". Applicant has not pointed out where this amended limitation is supported, nor does there appear to be a written description of the limitations. Examiner notes that section 0048, lines 1-11 of the instant application mentions computer web interface, but the web interface in claims 6 and 17 is not described sufficiently in the disclosure. For example, none of the drawings show a web interface or anything remotely connected with a web interface (e.g. the Internet).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 6 and 17 recite the limitation "the group". There is insufficient antecedent basis for this limitation in these claims.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 14-16 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S.

Patent Application Publication Number US 2002/0077157 by Okun et al, hereinafter Okun.

Regarding claim 14, Okun discloses a telecommunications system (see Figure 1a; section 0013, lines 1-8), comprising a home location register (Figure 1A, 110) for storing a profile of a user of a telecommunications device (Figure 1A, 126), wherein the profile includes an indication of whether the user is a subscriber to an incoming call hold service implemented by the telecommunications system (section 0014, lines 1-6; section 0036, lines 1-8; section 0039, line 1 – section 0040, line 11; section 0044, lines 1-14; section 0077, lines 1-12); a services node or serving MSC (Figure 1A, 118) for: determining whether an incoming call placed to the telecommunications device by a calling party should be placed on hold prior to the call being

Art Unit: 2645

answered by the user of the telecommunications device according to the incoming call hold service; placing the incoming call on hold prior to the call being answered; playing a message to the calling party (section 0054, line 1 – section 0057, line 13); and connecting the telecommunications device to the calling party if the user of the telecommunications device answers the incoming call (section 0058, line 1 – section 0063, line 10); and a mobile switching center or originating MSC (Figure 1A, 102) for facilitating communication between the telecommunications device, the services node, and the home location register (section 0054, lines 5-12).

Regarding claim 15, the system of claim 14 mentioned above, wherein Okun further discloses the services node includes an enunciator or IVR (section 0057, lines 5-9; section 0061, lines 10-14).

Regarding claim 16, the system of claim 15 mentioned above, wherein Okun further discloses the enunciator is for playing a message to a calling party when a call is placed on hold (section 0057, lines 5-9; section 0061, line 10 – section 0062, line 10).

Response to Arguments

8. Applicant's arguments, see Amendment, filed January 14, 2005, with respect to the rejection(s) of claim(s) 6-13 and 17-20 under Cannon in view of Koch and claim(s) 14-16 under Koch in view of Shah have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made of claim(s) 6-20, please see all rejections above.

9. Accordingly, this action is **NON-FINAL**.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent No. 5,329,578 by Brennan et al disclose a system for placing a calling party on hold based on a called party's profile stored in a database
- U.S. Patent No. 6,393,272 by Cannon et al disclose a wireless answer and hold feature wherein an incoming call to a telecommunications device from a calling party is placed on hold prior to being answered by a called party

11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9314 (for formal communications intended for entry)

Or call:

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to: Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (703) 305-4302. The examiner can normally be reached on M-F 8:30-5:30.

Art Unit: 2645

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

LH

lh

January 28, 2005

R L A 1/3/05
RONALD G. FOSTER
PRIMARY PATENT EXAMINER